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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/510,061	02/22/2000	Klaus Hobel	ACO2603PIUS	1447

7590 05/03/2005

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/510,061

Applicant(s)

HOBEL ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004 and 31 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14 is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-13, 16-20 and 24 is/are rejected.
- 7) ☒ Claim(s) 7-9 and 21-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. PCT/EP98/05487.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Applicants' amendment of January 31, 2005 has been considered. With respect to claim 1, the subject matter within single brackets remains within the claim as claimed subject matter, since 37 CFR 1.121 makes clear that deleted subject matter can only be denoted by strikethrough or double brackets. Furthermore, if applicants intend to delete formula (XIV), then claim 8 would no longer be further limiting.

2. The terminal disclaimer filed on January 31, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. 6,297,329 has been reviewed and is accepted. The terminal disclaimer has been recorded.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 10, 11, 16-19, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Hall et al. ('798).

Patentees disclose coating compositions comprising polyisocyanates and bicyclo-orthoester compounds containing acrylate or methacrylate groups. See abstract; column 2; and column 3, lines 1-27 within the references. The disclosed bicyclo-orthoester meets applicants' bicyclo-orthoester when C is a functional group corresponding to structure (IX) or (X).

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5. Applicants have argued that the reference, as it pertains to polymers resulting from the reaction of polyisocyanates, requires the presence of products resulting from the addition polymerization of the orthoester compounds. Applicants further argue that these addition polymers lack the ethylenically unsaturated double bonds required of the instantly claimed orthoester compound. This response has been carefully considered and the disclosure within column 3, lines 1-27 of the reference has been carefully considered. Applicants' argument is considered to be relevant only for the relatively high molecular weight resins disclosed within column 3, lines 16-22; the reference discloses that applicants' argued addition polymerization yields these relatively high molecular weight resins. However, the reference further teaches at column 3, lines 22-27 that relatively low molecular weight resins can be crosslinked by reaction with polyisocyanates. Since the relatively low molecular weight resins do not correspond to the aforementioned relatively high molecular weight resins, the position is taken that these low molecular weight resins correspond to the pre-addition polymerized orthoesters that contain unsaturated double bonds and that applicants' argument does not apply to such unsaturated resins or compounds.

6. Claims 1-6, 10-13, 16-20, and 24 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 97/31073 and 35 U.S.C. 102(e) as being anticipated by van den Berg et al. ('329 or '479).

WO 97/31073 and van den Berg et al. disclose coating compositions comprising a hydroxyl-reactive group containing compound and a bicyclo-orthoester compound that contains alk(en)yl groups containing hydroxyl-reactive groups, such as ester or epoxy groups. See abstracts and definitions of R_1 and R_2 . The references further disclose the use of catalysts to free

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the latent hydroxyl groups and to promote the reaction of the hydroxyl groups with the hydroxyl-reactive groups. Applicants' claimed definitions of B and C encompass the compounds of the references.

7. Applicants' response has been considered; however, the response fails to appreciate that the definitions of R_1 and R_2 within the references encompass species that satisfy the instantly claimed linkages represented by $(R_1 \text{ or } R_2\text{-B-C})$. For example, according to the references, R_1 or R_2 may be an alkenyl group containing an oxygen atom; therefore, when instant R_1 or R_2 and B are carbon atoms and instant C corresponds to (XII) (claim 10), the disclosed linkage causes the instantly claimed compound to be encompassed by the references. This analysis is also relevant for other claimed formula species, such as ester and urethane species. It is not seen that applicants' response has distinguished the respective compounds.

8. Claims 7-9 and 21-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent
April 30, 2005